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EXAMINER

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**Technology Center 2600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/600,458  
Filing Date: August 14, 2000  
Appellant(s): SASSE, ANDREAS

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Jason A. Houser  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 12/22/05 appealing from the Office action mailed 6/30/05.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

196,10,840	Eul	09-1997
6,317,131	Basso	11-2001
6,564,048	Sugita	05-2003
6,011,976	Michaels	01-2000

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-12,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eul [DE 196 10 840 A1] in view of Basso [US 6,317,131] and further in view of Sugita [US .6,564,048].

Regarding claim 1, Eul discloses a procedure to load electronic games on a mobile communication transmitter of a mobile communication network. Further, Eul discloses a method of communicating between a subscriber (MS in Fig.1) and value added service node (SE/SCP IN Fig. 1) relative to value added services offered with the objects, the objects including one of executable programs, functions and data and further controlling, modifying or executing the

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objects via the wireless interface of the mobile communication system (see translation document: Fig. 1, page 5, paragraphs 1,2; page 6, paragraph 2; page 7, paragraphs 1,2; page 11, paragraphs 1,2). Eul further discloses the method of transferring, activating, modifying and updating taking place via SMS (see translation document: page 13, paragraph 2). Eul however does not disclose a method of verifying the technical capability of the communicating device and further the application/object adapting to the technical capability of the communication device that has requested the object/application and loading into the mobile station an object suitable to the technical capabilities of the mobile station, wherein the technical capabilities of the mobile station are stored in a special database.

Basso teaches this limitation where multimedia data is displayed based on both the user preferences and terminal capabilities (see background of invention, summary of invention, col.2, lines 54-58, col. 3, 15-40).

Eul and Basso are combinable since they are from the same field of endeavor, i.e., interaction for multimedia delivery and presentation using nodes in a communication network. At the time of invention, it would have been obvious to one with ordinary skill in the art to provide the teachings of Basso to Eul in order to launch the object in an optimal manner that uses only those properties and features that are available on the particular portable device.

Eul and Basso teach all the limitations as claimed. However they fail to teach a method of comparing the version number of the available object with a version number of the object available in the mobile station and loading the more up-to-date object in the mobile station.

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Sugita, in the same field of endeavor, teaches a method of comparing the version number of the available object with a version number of the object available in the mobile station and loading the more up-to-date object in the mobile station. See col. 2, lines 23-45 and col. 3, lines 42-54. Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the teachings of Sugita to Eul and Basso so that the value added service with more improved features can be used.

Regarding claims 2, Eul further discloses a method where the applications/objects are loaded via the aerial interface (see translation document: Fig. 1, page 5, paragraphs 1,2; page 6, paragraph 2; page 7, paragraphs 1,2; page 11, paragraphs 1,2).

Regarding claim 3, Eul further discloses a method where the applications are loaded and modified by the operators via wireless interface (see translation document: Fig. 1, page 5, paragraphs 1,2; page 6, paragraph 2; page 7, paragraphs 1,2; page 11, paragraphs 1,2).

Regarding claim 4, Eul further discloses the method of displaying the applications/objects in a menu application (see translation document: page 6, paragraph 2).

Regarding claim 5, Eul further discloses a method where an application enables the response to a query by means of loading a new object/application in dependence of the action previously executed (see translation document: Fig. 1, page 5, paragraphs 1,2; page 6, paragraph 2; page 7, paragraphs 1,2; page 11, paragraphs 1,2).

Regarding claim 6, Eul further discloses a method where the applications are stored in a central database/server and is loaded into the mobile station (see translation document: Fig. 1, page 5, paragraphs 1,2; page 6, paragraph 2; page 7, paragraphs 1,2; page 11, paragraphs 1,2).

Regarding claim 7, Eul further discloses a method where the applications are loaded and stored in the permanent memory of the mobile terminal (see translation document: Fig. 3 and page 12).

Regarding claims 9, Eul further discloses the method of transferring, activating, modifying and updating taking place via SMS (see translation document: page 13, paragraph 2).

Regarding claims 10,15 Eul further discloses a method where keys/combination of keys are allocated by the applications to indicate functions of Value added services (see translation document: Fig. 3 and page 12)

Regarding claims 11 and 12, Eul further discloses a method where the loading of the application(s) is carried out by selected events initiated by the subscriber (see translation document: Fig. 1, page 5, paragraphs 1,2; page 6, paragraph 2; page 7, paragraphs 1,2; page 11, paragraphs 1,2).

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2. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eul [DE 196 10 840 A1] Basso [US 6,317,131] and Sugita [US 6,564,048] in view of Michaels [US 6,011,976].

Regarding claim 8, modified Eul teach all the limitations as claimed. However they fail to teach a method of downloading the object/game into the subscriber identity module (SIM) of the mobile unit.

Michaels, in the same field of endeavor i.e. a telecommunications system with value added service, teaches a method of downloading application data file programs into the SIM card (see col. 5, line 45 – col. 6, line 36).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the teachings of Michaels to modified Eul in order to facilitate the user to access the object/game even if the user has been disconnected from the mobile phone network.

#### **(10) Response to Argument**

**A. The appellant argues that the independent claim 1 and the dependent claims 2-12,15 are not rendered obvious by Eul '840 in view of Basso '131 and further in view of Sugita '048.**

The appellant (on page 8, paragraph 1) argues that Eul '840 fails to disclose or suggest the steps of verifying with the data/game the technical capabilities of the communication transmitter and the data automatically adapting thereto; communicating a short message from the control device to the communication transmitter containing the version number of the available data/game and loading a more up-to-date version if available; and communicating a short



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message from the control device to a subscriber identity module which updates a display of the communication transmitter upon successful completion of an operation in the control device, the operation selected by the user of the communication transmitter.

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The examiner would like to draw the appellant's attention to the Eul reference where Eul discloses a procedure to load electronic games on a mobile communication transmitter of a mobile communication network. Further, Eul discloses a method of:

- communicating between a subscriber (MS in Fig.1) and value added service node (SE/SCP IN Fig. 1) relative to value added services offered with the objects, the objects including one of executable programs, functions and data
- controlling, modifying or executing the objects via the wireless interface of the mobile communication system (see translation document: Fig. 1, page 5, paragraphs 1,2; page 6, paragraph 2; page 7, paragraphs 1,2; page 11, paragraphs 1,2).
- transferring, activating, modifying and updating taking place via SMS (see translation document: page 13, paragraph 2).

The examiner however agrees that the Eul reference does not disclose a method of verifying with the data/game the technical capabilities of the communication transmitter and the data automatically adapting thereto.

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The secondary reference Basso overcomes this deficiency in the Eul reference where Basso teaches a method of distributing and displaying multimedia data based on both the user preferences and terminal capabilities (see background of invention, summary of invention, col.2, lines 54-58, col. 3, 15-40).

Since both Eul and Basso reference are directed toward the distribution and presentation of multimedia data, they are in the same field of endeavor and hence at the time of invention, it would have been obvious to one with ordinary skill in the art to modify Eul in order to improve the quality of what is displayed based on both user preferences and terminal capabilities as taught by Basso (see col. 2, lines 15-19).

Further, the appellant (on page 8, paragraph 2) argues that Basso et al. '131 and Sugita '048 together or alone disclose or suggest the steps of communicating a short message from the value added services node to the mobile station containing the version number of the object available from the value added services node and communicating a short message from the value added services node to the subscriber identity module which updates a display of the mobile station upon successful completion of an operation in the value added services node, the operation selected by the user of the mobile station.

Again, in response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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The examiner would like to draw the attention to the Eul, Basso and Sugita references.

Eul discloses a method of:

- communicating between a subscriber (MS in Fig.1) and value added service node (SE/SCP IN Fig. 1, see translation document: Fig. 1, page 5, paragraphs 1,2; page 6, paragraph 2; page 7, paragraphs 1,2; page 11, paragraphs 1,2).
- transferring, activating, modifying and updating taking place via SMS (see translation document: page 13, paragraph 2).

Basso, teaches a method of:

- distributing and displaying multimedia data based on both the user preferences and terminal capabilities (see background of invention, summary of invention, col.2, lines 54-58, col. 3, 15-40).

Sugita teaches a method of:

- receiving version number in the information packet and comparing the version number of the available object with a version number of the object available in the mobile station and loading the more up-to-date object in the mobile station. See col. 2, lines 23-45 and col. 3, lines 42-54.

Since the references are directed towards receiving information services and display of information/multimedia services and updating the information services, the references are in the same field of endeavor and hence can be combined. Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the teachings of Sugita to Eul and Basso so that the value added service with more up to date features and thus efficient information provision services as required can be provided (see Sugita, col. 2, lines 45-50).

The appellant (on page 9, paragraph 1) again argues that three references fails to teach the steps of communicating a short message from the value added services node to the mobile station containing the version number of the object available from the value added services node; and communicating a short message from the value added services node to the subscriber identity module which updates a display of the mobile station upon successful completion of an operation in the value added services node, the operation selected by the user of the mobile station. In particular the applicant argues that the combination of the three references fail to teach the steps of communicating a short message service from the value added service node to the mobile device containing the version number of the object available from the value added service node.

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The examiner respectfully disagrees and points that the Eul reference discloses a method of communicating a short message service from the value added service node to the mobile device. See page 13 of the english translation. The Sugita reference however teaches a method of receiving a version number in the header packet of the information, which is then updated in the mobile device.

Since the references are directed towards receiving information services and display of information/multimedia services and updating the information services, the references are in the same field of endeavor and hence can be combined. Therefore it would have been obvious to one

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with ordinary skill in the art at the time the invention was made to include the teachings of Sugita to Eul and Basso so that the value added service with more up to date features and thus efficient information provision services as required can be provided (see Sugita, col. 2, lines 45-50).

Further the appellant (on page 9, paragraph 3) argues that a person of ordinary skill in the art would not be motivated to combine Basso et al. '131 with either Eul '840 or Sugita '048 because Basso et al. '131 is not in the same field of endeavor.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the examiner respectfully disagrees and would like to point out that the Eul and Basso reference are both directed towards the distribution and presentation of multimedia information. Although the Basso reference does not specifically deal with mobile communication device, it is still directed towards the distribution and presentation of multimedia information in a terminal device according to the capability of the terminal device.

Hence, they are in the same field of endeavor and therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Eul to incorporate the method of displaying the multimedia information according to the terminal capability as

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taught by Basso in order to improve the quality of what is displayed based on both user preferences and terminal capabilities (see col. 2, lines 15-19).

The appellant (on page 10, paragraphs 1,2) argues and points that the examiner has failed to show where and how the prior art suggests the desirability of the combination.

The examiner would like to draw the appellant's attention to Basso's reference where the invention is directed to improve the quality of what is displayed based on both user preferences and terminal capabilities as taught by Basso (see col. 2, lines 15-19). Therefore at the time of invention, it would have been obvious to one with ordinary skill in the art to modify Eul with Basso's teachings in order to improve the quality of what is displayed based on both user preferences and terminal capabilities.

**B. Appellant argues that claim 8 is not rendered obvious over Eul '840, Basso et al. '131, and Sugita '048 in view of Michaels et al. '976.**

The appellant argues that Claim 8, which depends from Claim 1, is not rendered obvious over Eul '840 in view of Basso et al. '131 and Sugita '048. and further in view of Michaels et al. '976.

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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The examiner respectfully disagrees. The examiner would like to point out that as discussed in the above section of addressing the rejection of Claim 1, Eul as modified by Basso and Sugita teach all the limitations as claimed.

However, the examiner agrees that the combination of Eul, Basso and Sugita fail to teach a method of downloading the object/game into the subscriber identity module (SIM) of the mobile unit.

Michaels, in the same field of endeavor, teaches a method of downloading application data file programs into the SIM card (see col. 5, line 45 – col. 6, line 36). The advantages of storing the value added service in the integrated/SIM card allows the subscriber to recall the information and use the information from the subscriber unit whenever required (see col. 1, lines 25-27 and 43-47). Another advantage of using the SIM card to store information is particularly useful when subscribers roam from one area to another and have no knowledge of local services (see col. 6, lines 1-7). Further as pointed by Michaels in col. 6, lines 20-31, dynamically updatable services can be added and once the card has the extra services they will continue to function even if the subscriber has been disconnected from the mobile network.

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the teachings of Michaels to modified Eul in order to facilitate the user to access the object/game even if the user has been disconnected from the mobile phone network.

Therefore the rejections of the claims as discussed in the office action mailed 6/30/05 and as discussed in this office action are considered proper.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

*Sujatha Sharma*

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Examiner Art Unit 2618

March 15, 2006

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